

## BEST AVAILABLE COPY

Serial No. 10/690,098

- 9 -

- 6 -

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REMARKS

Applicant thanks the Examiner for the courtesies extended during an interview with Applicant's representative on February 16. This amendment summarizes the changes and discussion held at the interview.

The present application is a continuation application in which original claims 1-23 were canceled and new claims 24-43 were added. In response to a Restriction Requirement, claims 36, 37 and 43 were withdrawn.

In an Office Action dated January 27, 2005, the Examiner rejected all claims, but indicated that claim 41 would be allowable if rewritten into independent form. By the present amendment, dependent claim 41 has been cancelled and replaced with new claim 44, which is equivalent to claim 41, rewritten in independent form. At the interview, the Examiner indicated that this claim appeared to be in condition for allowance, along with new dependant claims 45-57, which depend from allowable claim 44, and are allowable therewith.

As discussed at the interview, claims 24 and 38 have been amended to provide that the outer shell is one piece. The Examiner indicated that claim 38, as amended, appeared allowable. As such claims 38, and dependent claims 39, 40 and 42 are in condition for allowance. No agreement was reached on claim 24, but the Examiner agreed to consider the claim, as amended herein.

Claim 24

Independent claim 24 stands rejected over the combination of Todd and Rollor, further in view of U.S. Patent No. 1,721,311 to Muenchen. The Examiner relies on the combination of Todd and Rollor to provide an insulated container with a phase change material. However, as noted by the Examiner, the Todd reference fails to provide a phase change material for regeneratively absorbing thermal energy from a hot beverage. The Examiner relies on the Rollor reference to provide the phase change material missing from the Todd reference.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the

Serial No. 10/690,098

- 10 -

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50703sh

proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

The prior art fails to recognize the advantages of providing high quality insulation between the phase change material and the outside environment. The prior art appears to take the mistaken view that the main criteria for provided a usable regenerative container for hot beverages is the provision of phase change material. The present invention recognizes that insulating the phase change material chamber is preferred. The fact that one reference provides insulation, and another provides a phase change material, merely emphasizes the failure of the prior art to recognize the benefit of the presently claimed combination.

Neither Todd nor Rollor provides any motivation for the combination and reconstruction suggested by the Examiner. The Todd reference fails to recognize or suggest the use of a phase change material. Todd does not suggest that any improvement or change to the disclosed drinking receptacle is needed or desirable. The Rollor reference does provide a phase change material, but the construction of the container is completely different than in the present invention or in the Todd reference. Further, Rollor does not suggest that the phase change material from this container should be applied to a container such as Todd. Also, Rollor does not suggest that a construction approach, other than the approach disclosed, is necessary or desirable.

Independent claim 24 requires an inner vessel and a vacuum insulated outer shell with the phase change material disposed in a chamber between the inner vessel and the outer shell. Even if Todd and Rollor were to be combined as suggested by the Examiner, the combination fails to provide a vacuum insulated outer shell. The Examiner therefore relies on the Muenchen reference. Muenchen, like Todd, fails to provide a phase change material for regeneratively absorbing thermal energy from the liquid and then releasing the thermal energy to the liquid to maintain the temperature of the liquid. Instead, the Muenchen reference is merely designed to quickly chill the contents of a container using ice water. As such, Muenchen does not contemplate or suggest a combination with a drinking receptacle, such as Todd or Rollor. The examiner relies on the Muenchen reference to provide a vacuum insulated outer

Serial No. 10/690,098

- 11 -

50703sh

shell. Muenchen merely provides a glass insulator. Such a design is fragile and bulky, as clearly shown by the Muenchen drawings. Attempting to combine the Muenchen glass insulator with the more robust designs of Roller and Todd would require significant reconstruction of all three devices, leading to a likely nonfunctional design. Neither Rollor or Todd suggest the need for such an outer shell, and their designs do not allow room for an effective vacuum insulated outer shell. In addition, as discussed above, there is no motivation for the combination of the Todd and Rollor references.

By the present amendment, claim 24 has been amended to provide that the outer shell is one piece. This further distinguishes the cited references. In light of this, Applicant respectfully submits that claim 24 is in condition for allowance, along with claims 25-37 which depend therefrom.

#### Claim 58

New independent claim 58 is a revised version of original independent claim 24, providing that the outer layer of the outer shell forms at least part of the outer surface of the liquid receptacle. This further distinguishes the combination suggested by the Examiner, since the Muenchen reference clearly does not provide a vacuum insulated shell that forms part of the outer surface of the vessel.

This claim was discussed at the interview, and the Examiner indicated that patents to Hosford and Potter show vacuum insulated containers where the vacuum insulated portion forms the outer wall. However, these patents merely show traditional vacuum insulated containers, not containers with phase change material to regeneratively absorb thermal energy from a hot liquid. The combination suggested by the Examiner is not motivated by the prior art, which fails to recognize the advantages of the presently claimed combination. The existence of vacuum insulated containers does not motivate one of skill in the art to make the combination claimed, or to make the combination in the specific arrangement claimed.

#### Terminal Disclaimer

As agreed at the interview, Applicant submits herewith a terminal disclaimer.

In light of the above, Applicant respectfully submits that all pending claims are in condition for allowance.

Serial No. 10/690,098

- 12 -

50703sh

Respectfully submitted,

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